

REMARKS

Claims 1, 10, 13, 17, 24, and 28 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1, 3-7, 10, 11, 13-21, and 24 were rejected under 35 U.S.C. 103(a) as being anticipated by Moiroux et al. (US Patent No. 7,231,547) in view of Tallam (US Patent No. 6,948,099). Claims 8, 12, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable under Moiroux and Tallam in view of Neuman et al. (US PG PUB 20030217299).

Regarding the rejections under 35 U.S.C. 112, first paragraph, and the Examiner's remarks dated December 3, 2008. The Examiner asserts that it is obvious that a specific command may be needed in order to not erase volatile memory. Applicants agree that some embodiments may benefit from a specific command and that it is obvious to one in skill in the art when such a command is needed. However, it is also obvious that embodiments that do not cycle power during a reboot sequence would not benefit from such a command. Applicants note that obvious elements need not be included in a claim or specification for the specification to be enabling – particularly when they are not needed for all embodiments. Applicants assert the Examiner is contradicting his argument of lack of enablement by stating that the need for such a command is 'obvious'.

The Examiner noted that he is unclear as to why a reboot procedure is necessary in order to complete the indicated steps. The Background Section of the present application indicates that "what is needed is a device, system, and method of deterministically terminating existing processing...". As noted in the background section a "data saving process may be slowed by existing processes that were already running under the standard operating kernel...". As noted in the summary of the invention, the "data transfer kernel may be configured **to exclusively support processes and interrupts required to complete the data save procedure**". In other words, rebooting to the data transfer kernel disables all existing processes and enables the data saving processes to have exclusive control of the computing resources and expedite the data saving procedure. As a result, the claimed invention "facilitates rapid, deterministic data save operations from volatile computer memory to non-volatile storage devices **while protecting against process instability or stalling**. The present invention further **decreases the time required to save data** prior to shutting down a computer system." (See the last paragraph of the invention summary.)

Given the foregoing, Applicants assert that the specification enables one of skill in the art to understand the necessity of rebooting to prevent **process instability or stalling**. Applicants therefore assert that the specification is clear to one of skill in the art.

Regarding the assertion that term “reboot” requires a USC 112 rejection. Applicants assert that a reboot sequence that maintains the integrity of volatile memory is well known art – particularly for storage subsystems which is the environment for which the present invention was developed. It is not necessary to enable the invention in all possible environments or systems. The standard for declaring a disclosure to be inadequate is:

To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation [*Emphasis Added*].

Applicants submit that the Examiner has not shown that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation.

Regarding, the prior art of Moiroux and the rejections under 35 U.S.C. 103(a), Applicants have included an affidavit herewith under 35 U.S.C. 131 that overcomes the Moiroux reference. Applicants have attached hereto a number of exhibits referenced in the affidavit including an internal disclosure document from IBM that is dated 22 October 2002. Applicants assert that the disclosure document shows that the Applicants were in possession of the claimed invention on or before 22 October 2002. The disclosure was followed with diligence in reduction to practice resulting in the filing of the present application on 16 October 2003.

Given the foregoing, Applicants submit that the cited reference of Moiroux is not prior art and the rejection under 35 U.S.C. 103 is improper. Applicants therefore assert that each of the pending claims is in condition for allowance. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

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